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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,334	05/11/2001	Dan Kikinis	004688.P016	7799
52940	7590	07/27/2005		
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			EXAMINER LAYE, JADE O	
			ART UNIT 2617	PAPER NUMBER
DATE MAILED: 07/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/854,334	KIKINIS ET AL.	
	Examiner	Art Unit	
	Jade O. Laye	2617	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/15/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's amendments and arguments filed 6/15/05 have been entered of record and fully considered, respectively. However, Applicant's arguments are considered unpersuasive. Accordingly, **THIS ACTION IS MADE FINAL.**

Applicant argues "...*Clanton* significantly does not teach about the ability to select at least one of a plurality of objects stored at a user's location to generate an interactive 3-D EPG." (emphasis added) (Applicant's Arguments, Pg. 9). The Examiner finds this argument unpersuasive for two reasons:

- (1) Applicant's amended claim 1 does not recite "selecting" at least one of a plurality of objects.
- (2) *Clanton* does in fact disclose the limitations recited in amended claim 1.

The Examiner is not required to consider Applicant's argument regarding "selecting" objects because amended claim 1 does not recite this limitation. However, claim 1 does recite "using" at least one of a plurality of objects. Therefore, the Examiner's response will only address the portion of claim 1 which is directed to the "using" of at least one of a plurality of objects.

Clanton does teach "using at least one of a plurality of objects stored at a user's location," as recited in amended claim 1. At Column 7, Ln. 7-18 & Col. 10, Ln. 26-32, *Clanton* discloses the set top box memory stores the programming code and other data required to generate the 3-D user interface. Therefore, since the set top box is located at the user's location, said "plurality of objects" (i.e., program code and other data located within the set top box) is

located at the user's location. Accordingly, *Clanton* discloses all limitations of Applicant's amended claim 1.

Next, Applicant argues "*LaJoie* does not disclose a system which allows for selection of at least one of a plurality of locally stored objects for displaying the 3-D EPG." (Applicant's Response, Pg. 10). The Examiner agrees with Applicant's assertion. However, Applicant fails to recognize why the Examiner applied the *LoJoie* reference in the previous non-final action. *LoJoie* was applied not to teach selecting objects for displaying a 3-D EPG, but instead to teach "receiv[ing] localized content from a separate computer device," as recited in the originally filed claim 1. Since Applicant has now amended claim 1 to no longer recite this limitation, *LaJoie* is not needed. Accordingly, this will be reflected in the subsequent rejection.

Lastly, Applicant argues the *Kamen* reference is inapplicable because "...As shown by the records of the USPTO, at the time the invention in this application was made, the subject matter and claimed invention in this application and the '067 patent were entirely owned by the same entity...and were subject to an obligation of assignment to the same entity." (Applicant's Response, Pg. 10). The Examiner finds this argument unpersuasive because the USPTO records do not reflect common ownership or assignment at the time of Applicant's invention.

According to 35 USC 103(c), for applications filed on or after November 29, 1999, the rejection of record under *Kamen* is overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same persons. See MPEP § 706.02(I)(1) and § 706.02(I)(2). The "time of invention" of the present application is May of 2000 (provisional application date). Therefore, in order for Applicant to qualify for 35 USC 103(c) immunity, the *Kamen* reference and the present application must have been commonly owned by IsurfTV as of

May 2000. However, according to Reel/Frame 011829/0561, the present application was not assigned to IsurfTV until July of 2001, which of course, is not the “time of invention” for the present application. Therefore, Applicant’s argument is refuted by the very independent evidence he or she asserts. Accordingly, the Examiner maintains the position of the previous non-final action.

The remainder of Applicant’s arguments are moot in light of the previous discussion.

2. In view of Applicant’s amended Drawings and Claims, the objections applied in the previous Non-Final Action are hereby withdrawn.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 6/15/05 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

4. The drawings are objected to because the figures do not contain descriptive labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-6, 8, 12-17, 23, 24, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by *Clanton*, III et al. (US Pat. No. 5,745,710).

Applicant's claim 1 recites a system comprising:

- a. a unit to generate a 3-D EPG using at least one of a plurality of objects stored at a user's location; and
- b. a communication module coupled to a network in order to receive localized content

As to claim 1, *Clanton* discloses a system capable of generating a 3-D EPG (Fig. 7 & Col. 2, Ln. 43-67 thru Col. 3, Ln. 1-5) and displaying advertisements from local merchants (Col.

12, Ln. 14-17). It is inherent this localized content be provided via some form of communication module. Please refer to the previous arguments for a detailed explanation of the Examiner's position regarding the remaining limitations of claim 1. Accordingly, *Clanton* et al anticipate each and every limitation of claim 1.

Claims 12 and 23 are method and apparatus claims, respectively, which correspond to claim 1. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 2, *Clanton* further discloses the system comprises a set-top box and a television. (Fig. 1). Accordingly, *Clanton* et al anticipate each and every limitation of claim 2.

Claims 14 and 24 are method and apparatus claims, respectively, which correspond to claim 2. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 4, *Clanton* further discloses the system contains 3-D objects stored in memory (Col. 7, Ln. 15-18), which correspond to the programming events (Col. 8, Ln. 19-36 & Fig. 4-13). Selecting one of these 3-D objects will cause the system to display additional virtual worlds corresponding to the selected object. (Col. 9, Ln. 13-21). Accordingly, *Clanton* et al anticipate each and every limitation of claim 4

Method claims 13 and 15 and apparatus claim 26 correspond to system claim 4. Accordingly, they are analyzed and rejected as previously discussed.

As to claim 5, *Clanton* further discloses a 3-D EPG containing the title (Fig. 5) and channel identification (Fig. 10) of a program. (Note: The USPTO considers applicant's "at least one of" language to be anticipated by any reference containing one of the subsequent corresponding elements.) Moreover, *Clanton* incorporates by reference U.S. Patent #4,706,121 to Young, which discloses an EPG containing category, title, date, and the start time of television

programs. (*Clanton* Col. 2, Ln. 4-11). Accordingly, *Clanton* et al anticipate each and every limitation of claim 5.

Claims 16 and 27 are method and apparatus claims, respectively, which correspond to the system claim 5. Accordingly, each is analyzed and rejected as previously discussed.

As to claim 6, *Clanton* further discloses the system can display advertisements from local merchants. (Col. 12, Ln. 1-17). Accordingly, *Clanton* et al anticipate each and every limitation of claim 6.

Claim 17 corresponds to the system claim 6. Thus, it is analyzed and rejected as previously discussed.

As to claim 8, *Clanton* further discloses the system displays the interior of 3-D objects, such as the “Critic’s Café” of Figure 6, after they have been selected. (Col. 9, Ln. 15-21). Accordingly, *Clanton* et al anticipate each and every limitation of claim 8.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 3, 10, 11, 18-22, 25, 28-30, and 32-34 rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton* in view of *LaJoie* et al. (US Pat. No. 5,850,218).

Applicant’s claim 3 recites the system of claim 1, wherein the system includes a plurality of drivers, one of the drivers communicating with a separate unit to replenish programming information. Applicant has defined driver as a “connector”, and the examiner interprets it accordingly. (Spec. Page. 8, Par. [0026]). As discussed above, *Clanton* anticipates each and

every limitation of applicant's claim 1, but fails to teach the limitations of claim 3. However, within the same field of endeavor *LaJoie* discloses a similar system which is connected to a plurality of units, which enables it to provide an EPG, web browsing, email, online services, Near Video on Demand, Pay-Per-View, and Video on Demand services. (Col. 2, Ln. 1-11). Moreover, the examiner takes Official Notice that it is well known in this art that an EPG is capable of replenishing programming information. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combined teachings of *Clanton* and *LaJoie* to further include a well-known method of replenishing the EPG system in order to supply the user with current and up-to-date programming information.

Claim 25 is an apparatus claims which corresponds to system claim 3. It is analyzed and rejected as previously discussed.

Applicant's claim 7 recites the system of claim 4, wherein the memory in the system includes a third set of non-EPG objects including objects for e-commerce. Applicant did not provide a clear definition of "non-EPG" objects, therefore the examiner interprets the term to be objects that do not correspond to programming events. As discussed above, *Clanton* and *LaJoie* contain all limitations of claim 4 and *Clanton* further teaches the use of "extras", which advertise for various non-EPG services (pizza delivery, etc.). (Col. 12, Ln. 14-22). Combined with *LaJoie*'s online capabilities discussed above, these "extras" can be used in e-commerce. Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to further modify the combination of *Clanton* and *LaJoie* to also include the non-EPG "extras" teaching of *Clanton* in order to provide a method by which a user can partake in e-commerce.

Claims 18 and 28 are method and apparatus claims, respectively, corresponding to the system claim 7. Each is analyzed and rejected as previously discussed.

Applicant's claim 9 recites the system of claim 8, wherein a subset of the virtual world is displayed as a matrix of rectangular boxes containing current programming information. As discussed above, *Clanton* and *LaJoie* contain all limitations of claim 8, and *LoJoie* further discloses the EPG contains a matrix of rectangular boxes containing current programming. (Fig. 16). Thus, *Clanton* and *LaJoie* contain all limitations of applicant's claim 9.

Claims 20 and 30 are method and apparatus claims, respectively, which correspond to the system claim 9. Each is analyzed and rejected as previously discussed.

Applicant's claim 10 recites the system of claim 6, wherein the localized interactive content of the third set of objects is uploaded in real time. As discussed above, *LaJoie* discloses an EPG with Internet capabilities and *Clanton* discloses an EPG capable of displaying localized content. Those of ordinary skill in this art recognize it would have been obvious in systems having Internet capability, that they receive streaming data via a server which retrieves the data in real-time. Therefore, further modifications of the combined teachings of *Clanton* and *LaJoie* would result in a system which is capable of uploading localized content in real-time. Accordingly, each limitation of applicant's claim 10 is contained within the combined teachings of *Clanton* and *LaJoie*.

Claims 21 and 33 are method and apparatus claims, respectively, which correspond to the system claim 10. Each is analyzed and rejected as previously discussed.

Applicant's claim 11 recites the system of claim 10, which further includes an interface for a user to interact with the localized content of the 3-D EPG. As discussed above, *Clanton* and *LaJoie* contain all limitations of applicant's claim 10, and *Clanton* further discloses a user

interface in which the user can select “extras” corresponding to local services available to the user. (Col. 11, Ln. 54-67 through Col. 12, Ln. 1-17). Thus, *Clanton* and *LaJoie* contain all limitations of claim 11.

Claims 22 and 34 are method and apparatus claims, respectively, which correspond to the system claim 11. Each is analyzed and rejected as previously discussed.

Claim 19 mirrors the language of claim 8. Thus, it is analyzed and rejected as discussed therein.

Claim 29 mirrors the language of claim 8. Thus, it is analyzed and rejected as discussed therein.

Applicant’s claim 32 mirrors the language of claim 6. Thus, it is analyzed and rejected as discussed therein.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Clanton* in view of *LaJoie* as applied to claim 30 above, and further in view of *Kamen* et al. (US #6,421,067).

Applicant’s claim 31 recites the storage medium of claim 30, wherein a user of the system chooses a virtual world to display programming information. As discussed above, *Clanton* and *LaJoie* contain all limitations of claim 30 but fail to disclose a method by which the user is allowed to choose the virtual world that displays the program information. However, in the same field of endeavor, *Kamen* discloses a 3-D EPG system in which the user, via a remote control, can modify the EPG surfaces. *Kamen* allows the user to choose lighting, color, texture, or positions of objects within the 3-D space. (Col. 3, Ln. 35-65). Even though the user is not allowed to choose a completely new virtual world, he is still allowed to choose certain characteristics of the virtual world, which give it a new look and feel. Choosing a different

virtual world is only an obvious variant to manipulating the existing virtual world to give it a different look and feel, as in *Kamen*. Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the teachings of *Clanton* and *LaJoie* with the virtual world manipulating capabilities of *Kamen* in order to provide the user with a method of selecting and personalizing a virtual world of their choosing.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Nakano et al (US Pat. No. 6,043,818) disclose a 3-D EPG wherein the user can choose virtual worlds.
- b. Rovira (US Pat. No. 6,795,972) discloses a 3-D EPG in which a user can manipulate the world.
- c. Martino et al (US Pat. No. 6,662,177) disclose it was well known at time of applicant's invention to utilize various 3-D virtual worlds.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
July 21, 2005.



NGOC-YEN VU
PRIMARY EXAMINER